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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WILLIS, MICHAEL A

ART UNIT PAPER NUMBER

1617

DATE MAILED: 05/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,812

Applicant(s)

CANNELL ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-199 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 101-105, 115, 121, 123-127, 129-131, 142-152, 161, 166, 168-172, 174-177 and 187-199 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1-100, 106-114, 116-120, 122, 128, 132-141, 153-160, 162-165, 167, 173, and 178-186.

DETAILED ACTION

Claims 1-199 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 101-199, in Paper No. 6, submitted 11 March 2002 is acknowledged. In response to an election of species requirement, the species of XYLIANCE, xylose, and AMPHOMER LV-71 are elected.
2. Claims 1-100 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Claims 106-114, 116-120, 122, 128, 132-141, 153-160, 162-165, 167, 173, and 178-186 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected specie, there being no allowable generic or linking claim.
3. The traversal is on the grounds that the composition claims include the intended use, and that the US patent classification of Groups I and II are the same. Therefore, applicant argues that the search for an additional group does not constitute a serious burden. This is not found persuasive because intended use is not given patentable weight and the search includes non-patent literature. With respect to the election of species, applicant also argues that the examiner has failed to show that a serious burden exists. In response, the vast number of claimed species and various

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combinations of components represent a serious burden on the Examiner with respect to the search.

4. The requirement is still deemed proper and is therefore made FINAL. Claims 101-105, 115, 121, 123-127, 129-131, 142-152, 161, 166, 168-172, 174-177, and 187-199 are examined.

Specification

5. The disclosure is objected to because of the following informalities: page 9, lines 15-19 contain a "Brief Description of the Drawing". However, no drawings have been submitted. The objection can be overcome by removal of the paragraph. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 115 and 161 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 115 and 161 are rejected for being vague due to the term "derivatives". While a number of examples are given on pages 20 and 21 of the specification, the specification clearly indicates that these examples are non-limiting. One of ordinary skill in the art would not be apprised of the metes and bounds of the claimed "derivatives".

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For example, dihydroxyacetone can be derived from furanoses. It is unclear if dihydroxyacetone is within the limitations of claim 115.

9. Any remaining claims are rejected for depending from an indefinite base claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 101-105, 115, 121, 123-127, 129-131, 142-146, and 196-197 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bertho et al (US Pat. 5,688,930).

12. It is noted that the rejected claims are directed at compositions comprising at least one compound in an amount effective to protect keratinous fiber. The elected compound is XYLIANCE, which is described in the specification as a blend of hexadecyl and octadecyl glycosides. Claim 130 specifically claims 0.1-5% by weight as an effective amount.

13. Bertho discloses mixtures of alkyl glycosides from wheat by-products, such as wheat straw (see abstract). The mixtures are useful as surfactants, including hair care applications (see col. 6, lines 11-35, especially line 21). The mixture of glycosides includes glucose, xylose, and arabinose (see col. 2, lines 35-45). Xylose is inherently present in the mixtures. The alkyl groups taught by Bertho range from 6-22 carbon atoms, particularly 14-20 carbon atoms (see col. 3, lines 53-67; and col. 7, lines 6-9).

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Bertho discloses compositions containing the surfactant agents. The mixtures are included at 0.1-60% by weight in order to give surface-active properties to a composition (see col. 7, lines 13-18).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 101-105, 115, 121, 123-127, 129-131, 142-152, 161, 166, 168-172, 174-177, and 187-199 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karlen et al (US Pat. 6,004,545) in view of Bertho et al (US Pat. 5,688,930) or Bertho et al (US Pat. 6,087,403).

17. Karlen teaches a hair cleansing composition with fixing properties. Karlen teaches the compositions can contain amphoteric film-forming polymers (see col. 7, lines 4-15), specifically teaching that suitable amphoteric polymers for use in the

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compositions include AMPHOMER LV-71 (see col. 8, lines 1-16). The compositions necessarily include a surfactant chosen from a group that includes nonionic surfactants (see col. 2, lines 6-20). Karlen teaches that suitable nonionic surfactants such as alkylpolyglucosides are particularly preferred (see col. 4, lines 23-39). The reference lacks a mixture of hexadecyl and octadecyl glycosides.

18. Bertho ('930) teaches mixtures of alkyl glycosides from wheat by-products, such as wheat straw (see abstract). The mixtures are useful as surfactants, including hair care applications (see col. 6, lines 11-35, especially line 21). The mixture of glycosides includes glucose, xylose, and arabinose (see col. 2, lines 35-45). Xylose is inherently present in the mixtures. The alkyl groups taught by Bertho range from 6-22 carbon atoms, particularly 14-20 carbon atoms (see col. 3, lines 53-67; and col. 7, lines 6-9). The mixtures are included at 0.1-60% by weight in order to give surface-active properties to a composition (see col. 7, lines 13-18). The surfactants taught by Bertho come from cheap raw material and have economic advantages over alkylpolyglucosides (see col. 1, lines 35-53).

19. Bertho ('403) teaches emulsifying compositions based on fatty alcohols and polyglycoside mixtures (see col. 2, lines 52-67; col. 3, lines 1-40; and col. 5, lines 16-25). The compositions are used as emulsifiers (see col. 6, lines 31-43; and col. 7, lines 18-25). Bertho teaches that the compositions are advantageously cheaper than those based on purified glucose (see col. 5, lines 39-48).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Karlen by the use of


polyglycoside mixtures instead of alkylpolyglucosides in order to benefit from the emulsifying properties of the polyglycosides or economic advantages as taught by Bertho ('930) or Bertho ('403).

Conclusion


21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alternate Mon. and Tues. to Fri. from 9am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


Michael A. Willis
Examiner
Art Unit 1617

May 19, 2002


MICHAEL G. HARTLEY
PRIMARY EXAMINER